

**REMARKS**

This Amendment is submitted with an RCE, and is in response to the Office Action dated November 15, 2004, in which claim 11 was allowed and claims 1-10 and 12-23 were rejected. Specifically, claims 1, 12 and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by Newton (USP 4,443,949) and claims 2-10, 13-16 and 18-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Newton in view of Pressey (USP 4,584,780).

**Claims 2-3, 12-16, 18, and 20**

With this Amendment, claims 2-3, 12-16, 18, and 20 are canceled without prejudice, thereby rendering moot their rejection.

**Claim Rejections-35 U.S.C. §102(b)**

Claims 1 and 17 recite templates, for laying out electrical conduit entry hole positions on an electrical panel housing, that include (among other things) a spacer zone bordered on one side by a longitudinal straight edge and extending the length of the template, a marking zone, and a plurality of apertures centered on the marking zone. As amended, claims 1 and 17 specify that the spacer zone has a width in the transverse direction that is either about 3/4 of an inch or about 1 ½ inches to space conduit entry holes from the wall surface by a distance corresponding to the thickness of either 3/4 inch or 1 ½ inch thick support means used to secure the electrical conduit to the wall surface. In addition, amended claims 1 and 17 further specify that the centers of neighboring apertures are spaced from each other by at least about 1 ¾ inches.

Claim 1 and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by Newton. Newton discloses a template having a centerline and a pair of mirror image hole arrays located on each side of the centerline for symmetrically locating a pair of fasteners on a wall hanging such as a picture frame. Newton does not teach, suggest, or disclose a template with either (1) a spacer zone having a width in the transverse direction that is either about 3/4 of an inch or about 1 ½ inches or (2) apertures spaced by at

least about 1 ¾ inches. In fact, Newton does not disclose any particular width for a spacer zone nor any particular spacing distance for apertures. Moreover, for the reasons discussed below in regards to amended claim 7, neither the spacer zone feature nor the aperture spacing feature is disclosed in Pressey.

The above spacer zone feature recited in amended claims 1 and 17 is disclosed in the written description and, as such, does not constitute new matter. Canceled claim 20, as originally filed, recites a longitudinal spacer zone having a width of approximately either ¾ of an inch or 1 ½ inches. In addition, the above spacer zone feature is also supported by claims 2, 3, and 21 and the specification at page 7, lines 23-26.

Likewise, the above 1 ¾ inch aperture spacing feature recited in amended claims 1 and 17 is also disclosed in the written description and, as such, does not constitute new matter. The aperture spacing feature is taught in the Application at page 7, lines 18 and 19, which discloses a template where “the spacing between the centers of adjacent apertures is approximately an inch and three-quarters.” The aperture spacing feature is also supported by claims 5 and 10, as originally filed, which recite apertures that are spaced from one another with NECA spacing (i.e., National Electrical Contractors Association – see the Application at page 2, lines 26 - 28). NECA spacing guidelines for electrical contracting specify that the minimum spacing between centers of ¾ inch electrical conduit should be at least 1 ¾ inches, with larger sizes of electrical conduit being spaced by an even larger minimum spacing distance. As such, the minimum 1 ¾ inch aperture spacing feature of claims 1 and 17 is supported by the written description and does not constitute new matter.

Thus, for the above reasons, Newton does not teach, suggest, or disclose multiple features recited in amended independent claims 1 and 17. As such, claims 1 and 17 are not anticipated by Newton and the rejection of these claims under 35 U.S.C §102(b) should be withdrawn.

#### Claim Rejections-35 U.S.C. §103

Pending claims 4-10, 19, and 21-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Newton in view of Pressey. The Examiner asserts that Newton discloses all of the

features of these claims except for the specified claimed dimensions of the template and the template being made of metal. The Examiner cites Pressey to supply these deficiencies in Newton.

Amended independent claim 7 recites a template that includes (among other things) a sheet having a perimeter with a pair of parallel longitudinal straight edges; a  $\frac{3}{4}$  inch spacer zone extending the length of the template and bordered on one side by one of the longitudinal straight edges, wherein the width of the spacer zone in the transverse direction is approximately  $\frac{3}{4}$  of an inch; and a  $1\frac{1}{2}$  inch spacer zone extending the length of the template and bordered on one side by the second longitudinal straight edge, wherein the width of the spacer zone in the transverse direction is approximately  $1\frac{1}{2}$  inches. A longitudinal marking zone is sandwiched between the two spacer zones. A plurality of apertures are centered on the longitudinal marking zone, wherein centers of neighboring apertures are spaced from each other by at least about  $1\frac{3}{4}$  inches.

To reject a claim under 35 U.S.C. §103(a) as being obvious, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. 2143.03, citing In re Royka, 180 U.S.P.Q. 580 (C.C.P.A. 1964). As discussed above in regards to amended claims 1 and 17, Newton does not teach, suggest, or disclose (1) a plurality of apertures with centers that are spaced from the centers of neighboring apertures by at least about  $1\frac{3}{4}$  inches nor (2) a spacer zone having a width in the transverse direction that is about  $\frac{3}{4}$  of an inch, or (3) a spacer zone having a width in the transverse direction that is about  $1\frac{1}{2}$  inches.

Likewise, these features, as recited in amended claim 7, are not taught, suggested, or disclosed by Pressey. Pressey does not disclose spacing the centers of neighboring apertures on the template by at least about  $1\frac{3}{4}$  inches to ensure a minimum spacing distance between neighboring electrical conduit after installation in conduit entry holes marked using the template. Rather, Pressey discloses a template that, when being used to layout a plurality of conduit entry holes on an electrical panel, must be repositioned on the electrical panel to space the conduit entry holes and the corresponding electrical conduit. Moreover, the Pressey template does not include a spacer zone extending the length of the template, which necessitates the drawing of a datum line on the electrical panel housing to account for the

thickness of the support means to be used to secure the conduit to the wall surface upon which the electrical panel housing is mounted.

Furthermore, neither Newton nor Pressey teaches, suggests, or discloses a template having a pair of parallel spacer zones extending the length of the template and each bordering a different longitudinal straight edge. Thus, the rejection of claim 7 under 35 U.S.C. §103(a) should accordingly be withdrawn since the combination of Newton and Pressey does not teach each and every feature recited in amended claim 7. Likewise, since claims 8 and 9 depend from claim 7, the rejections of these claims under 35 U.S.C. §103(a) should also be withdrawn.

Similarly, the rejection of claims 4 - 6 (which depend from claim 1) and claims 19 and 21 - 23 (which depend from claim 17) under 35 U.S.C. §103(a) as being obvious in view of the combination of Newton and Pressey should also be withdrawn. Amended claims 1 and 17 each recite a template having both (1) a plurality of apertures with centers that are spaced from the centers of neighboring apertures by at least about  $1\frac{3}{4}$  and (2) a spacer zone having a width in the transverse direction that is either about  $\frac{3}{4}$  of an inch or about  $1\frac{1}{2}$  inches. As discussed above in regards to claim 7, the combination of Newton and Pressey does not teach, suggest, or disclose either of these features. Thus, since any claim depending from a patentable claim is also patentable, claims 4-6, 19, and 21-23 are patentable because independent claims 1 and 17 are patentable. See M.P.E.P. 2143.03, citing In Re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

**CONCLUSION**

In view of the foregoing, all of pending claims 1, 4-11, 17, 19, and 21-23 are in condition for allowance. Reconsideration and notice to that effect is respectfully requested. The Examiner is authorized to charge any additional fees associated with this application or credit any overpayment to Deposit Account No. 11-0982. Any inquiries regarding this application should be directed to David R. Fairbairn at 612-337-9357.

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